

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: KESTERSON et al.
Serial No.: 09/764,625
Filing Date: January 17, 2001
Confirmation No.: 8122
Group Art Unit: 2614
Examiner: Ramnandan P. Singh
Title: **SYSTEM AND METHOD FOR DISTRIBUTING
NETWORK COMMUNICATION SIGNALS**

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Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

PRE-APPEAL BRIEF REQUEST FOR REVIEW

The following Pre-Appeal Brief Request for Review ("Request") is being filed in accordance with the provisions set forth in the Official Gazette Notice of July 12, 2005 ("OG Notice"). Pursuant to the OG Notice, this Request is being filed concurrently with a Notice of Appeal. Applicants respectfully request reconsideration of the application in light of the remarks set forth below.

REMARKS

Applicants received an Office Action dated December 13, 2007 (“Office Action”). At the time of the Office Action, Claims 1, 3-9, 11-15, 17-19, 21-22, and 24-26 were pending, of which, Claims 1, 3-9, 11-15, 17-19, 21-22, and 24-26 were rejected. Applicants seek review of the rejections of Claims 1, 3, 5-6, and 9. Applicants do not seek review in this Request of the rejections of Claims 4, 7-8, 11-15, 17-19, 21-22, and 24-26.

Claim Rejections - 35 U.S.C. § 112, First Paragraph

The Office Action states that Claims 1, 3, 5-6, and 9 are rejected under 35 U.S.C. § 112, first paragraph, for failing to comply with the enablement requirement. Applicants respectfully traverse these rejections.

Applicants initially note that the Examiner has issued six Office Actions (March 17, 2005, November 11, 2005, April 20, 2006, October 2, 2006, December 4, 2006, and June 5, 2007, collectively, the “Prior Office Actions”) prior to the present action, addressing claims that are substantially identical, and in some cases precisely identical to those that are currently pending. None of the Prior Office Actions included any enablement rejection under 35 U.S.C. § 112, first paragraph. This directly contradicts the M.P.E.P.’s entreaty that, “if an enablement rejection is appropriate, the first Office action on the merits should present the best case with all the relevant reasons, issues, and evidence.” M.P.E.P. § 2164.04. Furthermore, in the Office Actions mailed April 20, 2006 and October 2, 2006, the Examiner indicated that Claims 3, 5-6, and 9 would be allowable if rewritten in independent format incorporating all the limitations of their respective base claims.

Nevertheless, the Examiner contends that the specification fails to describe how communication signals and communication paths are related to a communication coupling, network component, and communication system for transmission and reception. *Office Action*, pg. 4. The Specification discloses that communication signals are distributed between a communications network 52 and a communication system 36. *Specification*, pg. 7. Such signals may include analog telephone signals, ADSL signals, and Home PNA signals. *Specification*, pg. 13. The communication system 36 allows a user to connect multiple devices, such as telephones, mobile phones, or personal computers. *Specification*, pg. 8. Communication coupling 42 provides a user friendly coupling between network 52 and the

various devices of communication system 36, and may be used in lieu of multiple connectors, interfaces, and filters. *Specification*, pg. 7. Figure 1 shows an overview of the relationship between network 52, communication coupling 42, and communication system 36. More specifically, Figure 2B illustrates the internal wiring of communication coupling 42. Communication port 82 connects network 52 to communication coupling 42. *Specification*, pg. 14. Communication port 82 includes an inner pair and an outer pair of conductors. *Specification*, pg. 17. Switch 96 ensures that communication signals received by communication port 82 and the signals transmitted from communication port 82 will not share the same pair of conductors, avoiding interference between the two signals. *Specification*, pg. 4, 20. The additional description in the specification clearly delineates how, in various embodiments, signals are transmitted and received between network 52 and communication system 36, using communication coupling 42.

“The test of enablement is whether one reasonably skilled in the art could make and use the invention from the disclosures in the patent coupled with information known in the art, without undue experimentation”. See M.P.E.P. § 2164.01 (quoting *United States v. Telectronics, Inc.*, 857 F.2d 778 (Fed. Cir. 1988)). Applicants respectfully submit that, given the above description and wiring diagram, a person reasonably skilled in the art could make and use the communication coupling of Claim 1. Therefore, Applicants respectfully request that the rejection of Claim 1 under the first paragraph of 35 U.S.C. § 112 be withdrawn. Claims 3, 5-6, and 9 are allowable for analogous reasons.

Claim Rejections - 35 U.S.C. § 103

The Office Action states that Claim 1 is rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,014,299 to Klupt et al. (“*Klupt*”) in view of U.S. Patent No. 5,930,340 to Bell (“*Bell*”). Applicants respectfully traverse this rejection.

Claim 1 is directed to a communication coupling including a port having first and second paths of communication. The coupling further comprises a switch that is coupled with the first communication port. The switch has a first position in which the port is operable to: (i) receive a first communication signal from a network component using the first path of communication; and (ii) transmit a second communication signal to the network component using the second path of communication. The switch also has a second position

in which the port is operable to: (i) receive the first communication signal from the network component using the second path of communication; and (ii) transmit the second communication signal to the network component using the first path of communication. Neither *Klupt* nor *Bell*, alone or in combination, disclose each of these limitations.

The Office Action relies on terminals T1 and T2 of *Klupt* as disclosing the first communication port of Claim 1. *Office Action*, pg. 5. Additionally, the Office Action relies upon switch 29 of *Klupt* as disclosing the switch of Claim 1. *Office Action*, pg. 7. However, switch 29 has two positions: (i) a voice communication mode; and (ii) a data communication mode. *See Klupt*, col. 2, lines 46-54. In the voice communication mode the switch engages contacts C1 and C2. *See Klupt*, col. 4, lines 36-41, and Fig. 4. In the second position of the switch (i.e., data communication mode) the switch engages contacts C3 and C4. *See Klupt*, col. 4, lines 49-54, and Fig. 4. The position of switch 29 does not affect which path (of first and second paths) at the first communication port is used to receive and which is used to transmit. *Bell* fails to cure this deficiency. Therefore, Applicants respectfully request that the rejection of Claim 1 under 35 U.S.C. § 103 be withdrawn.

Request for Help

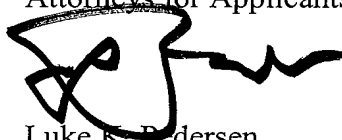
In the Office Action, the Examiner asked for help in “clearly understanding the claims.” *Office Action*, pg. 5. Applicants have done everything reasonably possible to accommodate this request. However, since the Examiner has failed to return Applicants’ phone calls for the two weeks prior to the due date for this response, Applicants will be unable to assist the Examiner any further, prior to this response.

Applicants scheduled a teleconference with the Examiner on February 28, 2008. During the call, the Examiner requested that Applicants provide a simplified version of the drawings to help the Examiner more clearly understand the invention. Applicants faxed information to Examiner on March 5, 2008 and followed up with a telephone call. Since then, Applicants have left four messages for the Examiner and none have been returned. On March 12, 2008, Applicants called Supervisor Fan Tsang. Supervisor Tsang immediately returned the call, but was unable to contact the Examiner and suggested that Applicants file a written response.

Conclusion

As the rejections of Claims 1, 3, 5-6, and 9 contain clear legal and factual deficiencies, Applicants respectfully request a finding of allowance of Claims 1, 3, 5-6, and 9. If the PTO determines that an interview is appropriate, Applicants would appreciate the opportunity to participate in such an interview. To the extent necessary, the Commissioner is hereby authorized to charge any required fees or credit any overpayments to Deposit Account No. **02-0384** of **Baker Botts L.L.P.**

Respectfully submitted,
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